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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,633	07/28/2006	Lilian Alcaraz	06275-518US1 101318-1P US	2655
26164 7590 09/01/2010 FISH & RICHARDSON P.C. P.O BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER CHANG, CELIA C	
			ART UNIT 1625	PAPER NUMBER
			NOTIFICATION DATE 09/01/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 10/587,633	Applicant(s) ALCARAZ ET AL.	
	Examiner Celia Chang	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 17 and 56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 17 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/17/10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment and response filed by applicants dated June 17, 2010 have been entered and considered carefully.

Claims 1-15, 18-55 have been canceled. Claims 16, 17, and newly added 56 are pending.

2. The rejection of claims 15-16 under 35 USC 112 first paragraph as failing too comply with the enablement requirement is dropped in view of the cancellation of claim 15 and the limitation of claim 16 being depended on claim 56 compounds.

3. The rejection of claim 15 under 35 USC 112 second paragraph is dropped in view of the cancellation of claim 15.

However, the 112 second paragraph rejection is applicable to claim 17. It is unclear what is the scope encompassed by the term “chemokine mediated” disease state. The term mediate includes both hyper and hypo activity of the chemokine and a compound cannot simultaneously active in both hyper and hypo-physiological function. In addition, it was evidenced in the copending case SN 10/504,936 that the Barnes and Boskabady references established that there is nexus between CCR3 receptor antagonistic activity or histamine H 1 inhibitory activity of such piperidiny compounds for the treatment of obstructive pulmonary disorders.

4. The rejection of claims 15-16, 18-27, 28-30, 34, 36-37, 40-44 and 54 under 35 USC 102(e) or 103(a) are dropped in view of the cancellation of claims 15, 18-27, 28-30, 34, 36-37, 40-44 and 54 and the limitation of claim 16 now depending on claim 56 compounds.

5. The provisional rejection under the judicially created doctrine of obviousness type double patenting is now made into nonprovisional double patenting because the copending claims have been issued. Claim 1 of US 7,709,500 generically embraced the instant compounds when R9 is substituted thiazole. The copending claims were allowed based on applicants argument that “If

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an earlier filed application has claims that are conflicting with those in a later filed application, and a provisional double patenting rejection is the only rejection remaining in the earlier filed application, then the Office should withdraw the double patenting rejection in the earlier filed application and allow it to issue without a terminal disclaimer. See MPEP § 822.01 and 804 (emphasis added)".

No acceptable terminal disclaimer was filed in the instant application.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang, Ph. D. whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres, Ph. D., can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Aug. 18, 2010

/Celia Chang/
Primary Examiner
Art Unit 1625